

ZAW AF
Patent 2135

Attorney Docket No. 032326-025



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

MAIL STOP AF

In re Patent Application of
Gilles Lisimaque
Application No.: 09/576,412
Filing Date: May 22, 2000
Title: PROCESS TO MANAGE DATA IN A CHIP CARD

Group Art Unit: 2135
Examiner: Beemnet Dada
Confirmation No.: 1838

AMENDMENT/REPLY TRANSMITTAL LETTER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Enclosed is a reply for the above-identified patent application.

- ☒ A Petition for Extension of Time is also enclosed.
- ☐ Terminal Disclaimer(s) and the ☐ \$65.00 (2814) ☐ \$130.00 (1814) fee per Disclaimer due under 37 C.F.R. § 1.20(d) are also enclosed.
- ☐ Also enclosed is/are _____

- ☐ Small entity status is hereby claimed.
- ☐ Applicant(s) requests continued examination under 37 C.F.R. § 1.114 and enclose the ☐ \$395.00 (2801) ☐ \$790.00 (1801) fee due under 37 C.F.R. § 1.17(e).
- ☐ Applicant(s) requests that any previously unentered after final amendments not be entered. Continued examination is requested based on the enclosed documents identified above.
- ☐ Applicant(s) previously submitted _____

_____ on _____
for which continued examination is requested.
- ☐ Applicant(s) requests suspension of action by the Office until at least _____, which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R. § 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.
- ☐ A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (1809/2809) is also enclosed.

- ☒ No additional claim fee is required.
- ☐ An additional claim fee is required, and is calculated as shown below.

AMENDED CLAIMS					
	No. of Claims	Highest No. of Claims Previously Paid For	Extra Claims	Rate	Additional Fee
Total Claims	17	MINUS 20 =	0	x \$50.00 (1202) =	\$ 0.00
Independent Claims	2	MINUS 3 =	0	x \$200.00 (1201) =	\$ 0.00
If Amendment adds multiple dependent claims, add \$360.00 (1203)					
Total Claim Amendment Fee					\$ 0.00
<input type="checkbox"/> Small Entity Status claimed - subtract 50% of Total Claim Amendment Fee					\$ 0.00
TOTAL ADDITIONAL CLAIM FEE DUE FOR THIS AMENDMENT					\$ 0.00

- ☐ A check in the amount of _____ is enclosed for the fee due.
- ☐ Charge _____ to Deposit Account No. 02-4800.
- ☐ Charge _____ to credit card. Form PTO-2038 is attached.

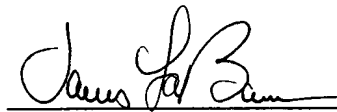
The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

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By



James A. LaBarre

Registration No. 28,632

Date: May 27, 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of **MAY 27 2005**) **MAIL STOP AF**
Gilles Lisimaque)
Application No.: 09/576,412) **Group Art Unit: 2135**
Filed: May 22, 2000) **Examiner: Beemnet Dada**
For: **PROCESS TO MANAGE DATA IN A**) **Confirmation No.: 1838**
CHIP CARD)
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REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated January 27, 2005, Applicant respectfully requests reconsideration and withdrawal of the rejections of the claims. The courteous interview conducted by Examiner Dada with Applicant's undersigned representative is noted with appreciation. The substance of that interview is set forth in the following remarks.

Claims 1-8 and 14-16 were rejected under 35 U.S.C. §103, on the grounds that they were considered to be unpatentable over the Ieki et al patent, in view of the Chen et al patent and in further view of the Bosen et al patent. The remaining claims were rejected on the basis of these three patents, in further view of the Drupsteen et al patent. For the reasons presented in Applicant's previous response, as well as those pointed out during the above-noted interview, it is respectfully submitted that the teachings of these patents do not suggest the claimed subject matter to a person of ordinary skill in the art.

As discussed in Applicant's previous responses, the claimed subject matter is directed to the management of data stored in a smart card, and is particularly concerned with the transfer of data from one card to another, for example when an older card is to be retired in favor of a newer card. Access to the data in each card is controlled by a respective management code, which is based upon a secret code that is entered by the user, such as a password or a PIN. In accordance with the claimed invention, a management code for the new card is generated on the basis of information relating to the old card. For instance, as depicted in Figure 2 of the application, the management code 14 for the first card is based upon a mother key 100 and the serial number 12 of the first card. This serial number is also stored in the second card 2, along with its own serial number 23. The algorithm 21 for calculating the management code 22 of the second card receives, as inputs, the serial number 23 of the second card and data relating to the first card, such as its serial number 12 and/or its management code 14.

The Ieki patent is not directed to this same type of situation, in which data from one card is transferred to another card. Rather, as discussed in the background portion of that patent, it is concerned with the need to regularly update the algorithm for enciphering data that is communicated between an IC card and a host computer. As described in the patent, the algorithm is typically stored in a ROM that is located in an intermediate communication device, e.g. a reader. When the algorithm is to be updated, the ROM containing the older algorithm must be replaced by a ROM storing the updated algorithm. This can result in a cumbersome procedure, particularly for the case in which the ROM is located in the communication device.

To alleviate the need for such a procedure, the Ieki patent discloses that the ROM can be provided in a separate IC card. In such a case, the communication device is provided with a first slot 13 to receive the principal IC card IC-2 that is used to communicate with a host computer HC, and a second slot 14 to receive the another IC card IC-1 containing the encryption algorithm. Consequently, when the encryption algorithm is to be updated, it is only necessary to substitute a new card IC-1 containing the upgraded algorithm, rather than having to replace the ROM within the communication device 10.

Thus, while the Ieki patent discloses a system in which two IC cards are employed, it is not concerned with the particular type of operation to which the present invention is directed, namely the transfer of data from one card to the other. Rather, in the system of the Ieki patent, the two IC cards perform entirely different functions. The card IC-1 essentially functions as a component of the communication device 10, to implement the encryption algorithm. The principal IC card, IC-2, is employed in a standard manner for communication with the host computer HC.

Claim 1 recites, among other elements, that data relating to the first card, as well as a second management code, are recorded in the second chip card. The Office Action asserts that the Ieki patent discloses this claimed feature, with reference to column 4, lines 38-46 and 62-67. It is respectfully submitted, however, that these portions of the patent do not disclose the claimed feature, nor do any other portions thereof.

First, it is not apparent from the rejection which card in the Ieki patent is considered to be the first card and which one is the second card. For purposes of this discussion, it will be assumed that the principal card for communication with the host computer, i.e., IC-2, is the first card. There is no disclosure in the Ieki patent that data relating to this card is

stored in the other IC card. At best, at column 4, lines 62-67, the patent discloses that new data to be written in the first card IC-2 is enciphered in the host computer and provided to the second card IC-1 to be deciphered. The deciphered data is then stored in the first card IC-2.

It is respectfully submitted that this disclosure does not constitute a teaching of storing data relating to the first card in the second card. The data that is sent to the card IC-1 to be deciphered is not data that *relates* to the first card. For instance, claim 6 recites that the data relating to the first card comprises identification data for the first card. Claim 7 recites that the data relating to the first card comprises a first management code for the first card. The Ieki patent does not disclose that the data that is deciphered in the card IC-1 *relates* to the card IC-2 in such a fashion, namely that it serves to identify the card or to control its operation.

Furthermore, another feature recited in claim 1 is that a second management code is produced on the basis of data relating to the first card and a set of identification data of the second card. It is "said" data relating to the first card that is stored in the second card. In other words, the data relating to the first card that is stored in the second card is also the data that is used to produce the second management code. There is no disclosure in the Ieki patent that any data passing through the card IC-1, to be deciphered and then subsequently stored in the card IC-2, is used to produce a management code for the card IC-1. Accordingly, even when the teachings of the Ieki patent are given their broadest reasonable interpretation, they still do not suggest the type of relationship that is recited in claim 1.

In addition to this claimed relationship, it is respectfully submitted that the combination of references does not disclose the concept of generating a second management

code in accordance with data relating to a first chip card and identification data of a second chip card. This subject matter is recited in both claim 1 and claim 14. The rejection acknowledges that this claimed feature is not taught by the Ieki and Chen patents, even when considered in combination. Accordingly, it relies upon the Bosen patent, particularly at column 4, lines 27-49 and column 6, lines 58-67. It is respectfully submitted, however, that the Bosen patent does not disclose, nor otherwise suggest, the claimed subject matter. In particular, it is not concerned with systems that employ chip cards, let alone first and second chip cards. Rather, as pointed out in Applicant's previous response, it discloses a system for dynamically generating a new password each time a user desires to access a computer. It is only concerned with access to a single device, or program. There is no teaching in this patent which would lead a person of ordinary skill in the art to generate a management code for a second device, such as a chip card, on the basis of data relating to a first device and identification data of the second device. Since the Bosen patent only relates to the operation of a single device, it is not seen how it can be interpreted to teach the generation of management codes that are based upon information relating to two different devices.

It is respectfully submitted that none of the three references teaches this concept. Consequently, any possible combination of their teachings cannot be deemed to suggest the claimed subject matter.

Furthermore, the Office Action does not provide any motivation that would lead a person of ordinary skill in the art to combine the teachings of the Bosen patent with the systems of the Ieki and Chen patents. As noted above, the Bosen patent has nothing to do with chip card systems, let alone systems that employ two chip cards. Consequently, it is

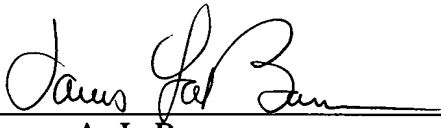
not apparent why a person of ordinary skill in the art would refer to the teachings of the Bosen patent, particularly if he were faced with the problem addressed by the present invention, namely the transfer of data from one chip card to another chip card. The issues addressed by the Bosen patent have nothing to do with this type of operation.

For the foregoing reasons, therefore, as well as those presented in Applicant's previous response, it is respectfully submitted that the Ieki, Chen and Bosen patents do not suggest the subject matter of the pending claims to a person of ordinary skill in the art, whether considered individually or in combination. Reconsideration and withdrawal of the rejections are therefore respectfully requested.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: May 27, 2005

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